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| Applicant: | Trung V. Le | Confirmation No. | 7391 |
| Serial No.: | 10/644,484 | Examiner: | Hung Thanh Nguyen |
| Filed: | August 20, 2003 | Group Art Unit: | 2841 |
| Docket No.: | 10383US01 | | |
| Title: | MEMORY CARD COMPATIBLE WITH MULTIPLE CONNECTOR STANDARDS | | |

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being transmitted by facsimile to the Commissioner for Patents, Alexandria, VA 22313-1450 on March 5, 2007.

By: 

Name: Eric D. Levinson

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant is re-instating an Appeal for this case following the Examiner's recent Office Action, which re-opened prosecution following Applicant's submission of an Appeal Brief.

Applicant respectfully requests a Pre-Appeal Brief Request for Review based upon the failure to establish a prima facie case of anticipation under 35 U.S.C. § 102 in the Office Action mailed December 18, 2006. As outlined in greater detail below, the applied references fail to disclose or suggest the claimed invention. For this reason, the anticipation rejections of claims 1, 7-13, 15, 19, 20, 23, 25 and 27 are in error and must be reversed.

For simplicity, Applicant has focused the arguments below on the pending independent claims. By setting forth these clear grounds of error, Applicant does not assert that these are the only errors in the Office Action, nor does Applicant waive any arguments that may be asserted in

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an Appeal Brief. Accordingly, Applicant reserves the right to further address the dependent claims in the Appeal Brief.

In the current Office Action, the Examiner rejected claims 1, 7-13, 15, 19, 20, 23, 25 and 27 under 35 U.S.C. 102(b) as being anticipated by Kaneko (JP2002084930 or US 2003/0221066). Previously, dependent claims 11, 19 and 20 had been rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Jones et al. (US 6,438,638), but following Applicant's Appeal Brief, the Examiner has now changed this rejection of claims 11, 19 and 20 to an anticipation rejection based on Kaneko. All other rejections are identical to those addressed in the Appeal Brief. Notably, the Examiner's new rejections of claims 11, 19 and 20 contradict the Examiner's previous position that Kaneko fails to disclose all the features of claims 11, 19 and 20.

Applicant's independent claims concern memory cards that include two different connectors. In order to accommodate these two connectors, Applicant's pending claims recite specific memory card architectures, which are fundamentally different than that taught by Kaneko. For this reason, the rejections under 35 U.S.C. 102 are improper and must be reversed. Accordingly, the current rejections advanced by the Examiner are erroneous and should be reversed at this Pre-Appeal Brief stage of the Appeal process.

All pending claims recite a memory card that includes a first connector that conforms to a first connector standard and a second connector that conforms to a second connector standard. Claims 1 and 15 are independent claims directed to memory cards. Claims 23 and 27 are independent claims directed to systems that include a memory card and the first and second devices to which the memory card can be attached via the first and second connectors. The memory card recited in claim 1 is similar to that recited in system claim 23, while the memory card recited in claim 15 is similar to that recited in new system claim 27. All of these claims also require that the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard.

As noted by the Examiner in the Office Action, Kaneko teaches a memory card that includes two different connectors. For purposes of this abbreviated Pre-Appeal Brief Request for Review, Applicant does not dispute the Examiner's conclusions that Kaneko discloses a first connector that complies with a host computer connector (HCC) standard and a second connector

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that complies with a device communication connector (DCC) standard, as required by all pending claims.

However, the memory card of Kaneko is fundamentally different than those recited in Applicant's claims in another respect. In particular, Applicant's claims recite different controller architectures than that of Kaneko. Kaneko lacks any suggestion, whatsoever, of the different controller architectures required by Applicant's different claims.

More specifically, claims 1 and 23 require that the memory card includes a controller that controls the memory and controls output via the first connector and the second connector. In stark contrast to this requirement of claims 1 and 23, Kaneko discloses a less efficient architecture that includes three different controllers. In particular, Kaneko discloses one controller for the memory, one for the first connector, and one for the second connector. None of the controllers of Kaneko, however, controls both the memory and output via the connectors, as required by claims 1 and 23.

Claims 15 and 27 require that the memory card include two controllers, i.e., first and second controllers. The first controller is electrically coupled to the memory and the first connector, and controls both the memory and output via the first connector. The second controller is electrically coupled to the second connector and the first controller, and the second controller controls output via the second connector.

Thus, claims 15 and 27 require two controllers, but one of the controllers controls both the memory and output via one of the connectors. This clearly distinguishes the claimed invention from Kaneko, which again, requires three different controllers for the memory, the first connector and the second connector, respectively. None of the controllers of Kaneko controls both the memory and output via a connector.

Applicant also respectively notes that the Examiner's analysis once again overlooks the different requirements of claims 15 and 27 relative to the requirements of claims 1 and 23. Indeed, the Examiner grouped all of claims 1, 15, 23 and 27 together in his analysis, notwithstanding the differences between claims 15 and 27 relative to claims 1 and 23. Applicant has addressed this point on several occasions, but the Examiner once again overlooked the differences between claims 1 and 23 and Kaneko, as well as the differences between claims 15 and 27 and Kaneko.

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In order to support an anticipation rejection under 35 U.S.C. 102, it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."¹ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102 is improper.²

In this case, Kaneko does not disclose or suggest a controller that controls the memory and controls output via the first connector and the second connector, as required by claims 1 and 23. Furthermore, Kaneko does not disclose or suggest a controller that controls both the memory and output via one of two different connectors, as required by claims 15 and 27. In the context of a memory card that includes two different connectors (as also required by Applicant's claims), the controller architectures recited in the different claims, as discussed above, are novel and non-obvious over the applied prior art.

In view of the fundamental distinctions outlined above, all pending rejections are improper and must be reversed.

Applicant also notes that many of the rejections of the dependent claims are clearly deficient. Moreover, the new rejections of claims 11, 19 and 20 are not only deficient, but contradict the Examiner's previous statements on the record that Kaneko fails to suggest these features. The current Office Action fails to explain the Examiner's change of position with respect to Kaneko relative to the features of claims 11, 19 and 20.

Applicant encourages the Examiner and the Pre-Appeal Brief Board to review all pending rejections, including the rejections of the independent claims (addressed above) as well as the rejections of various dependent claims. With respect to the dependent claims, Applicant's arguments that were advanced in the previously filed Appeal Brief are still valid.

Applicant reserves further comment at this time, but will present more thorough arguments with respect to the independent claims and various dependent claims if an Appeal Brief is deemed necessary.

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

² *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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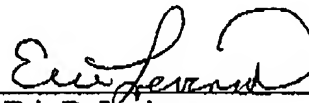
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration by the Pre-Appeal Brief Board and reversal of all pending rejections. Applicant also urges the Pre-Appeal Brief Board to recommend that the Examiner allow all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069.

Date:

By:

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